

REMARKS

At the time of the First Office Action dated November 20, 2007, claims 1-17 were pending in this application. Of those claims, claims 6-17 have been rejected and claims 1-6 have been withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b).

On page 2 of the First Office Action, the Examiner objected to claims 6-17 for various informalities. This objection is respectfully traversed. These alleged "informalities" appear to be a matter of personal preference and not related to any statutory deficiencies. Applicants, therefore, respectfully solicit withdrawal of the imposed objection to claims 6-17.

On page 3 of the First Office Action, the Examiner objected to the claims 12-17 under M.P.E.P. § 608.01. In this regard, Applicants note the Examiner's underlined sentence as to "new terms appearing in the claims." The claims being objected to are originally filed claims, and original claims constitute their own description.¹ Applicants, therefore, respectfully solicit withdrawal of the imposed objection to claims 12-17.

CLAIMS 7-11 AND 13-17 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

On pages 3 and 4 of the First Office Action, the Examiner identified perceived informalities generating antecedent basis issues. This rejection is traversed.

¹ In re Koller, 613 F.2d 819, 204 USPQ 702 (CCPA 1980).

Regarding subsection (b) of the Examiner's comments, Applicants note that each of claims 8, 11, 14, and 17 have been amended to recite "the new ...", and thus, Applicants respectfully submit that the Examiner's rejections as to these claims have been overcome.

Regarding the recitation of "the group" in claims 7 and 13, the Examiner is directed to M.P.E.P. § 802.02 as to Markush Claims. As evident from this first sentence, the format "selected from the group consisting of ..." has consistently been considered proper language.

Regarding "said determining and reconfiguring steps" in claims 11 and 17, the Examiner is directed to claims 9 and 15, each of which recites "steps of ... determining ... and, reconfiguring ..." Therefore, antecedent basis has been provided for "said determining and reconfiguring steps."

For the reasons presented above, Applicants respectfully solicit withdrawal of the imposed rejection to claims 7-11 and 13-17 under the second paragraph of 35 U.S.C. § 112.

CLAIMS 6-17 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON MALTZ ET AL., U.S. PATENT PUBLICATION NO. 2002/0143929 (HEREINAFTER MALTZ), IN VIEW OF NOZAWA ET AL., U.S. PATENT NO. 6,272,543 (HEREINAFTER NOZAWA)

On pages 4-7 of the First Office Action, the Examiner asserted that one having ordinary skill in the art would have been impelled to modify Maltz in view of Nozawa to arrive at the claimed invention. This rejection is respectfully traversed.

Obviousness is a legal conclusion based on underlying facts of four general types, all of which must be considered by the trier of fact: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) any objective indicia of nonobviousness.² Upon reviewing the Examiner's statement of the rejection with regard to claims 6 and 12 on page 5 of the First Office Action, Applicants submit that the Examiner has failed to clearly designate the teachings in Maltz being relied upon the statement of the rejection. In this regard, the Examiner's rejection under 35 U.S.C. § 103 also fails to comply with 37 C.F.R. § 1.104(c), which provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

The Examiner has not designated the particular parts of Maltz being relied "as nearly as practicable." Instead, the Examiner's statement of rejection reproduces entire passages of the claims and asserts that all the limitations in the particular passages are disclosed by certain cited passages within Maltz. Although broadly identifying where the Examiner believes the claimed limitations are disclosed in Maltz, the statement of the rejection fails to clearly identify many of the specific elements within Mason being relied upon in the rejection, as required by 37 C.F.R. § 1.104(c).

By not clearly indicating those specific elements being relied upon in the prior art to teach the invention, as recited in the claims, the Examiner has failed to fully establish the underlying facts regarding (1) the scope and content of the prior art and (3) the differences

² See *KSR Int'l v. Teleflex Inc.*, 550 U.S. ____ (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1270, 20 USPQ2d 1746, 1750-51 (Fed. Cir. 1991); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566-68, 1 USPQ2d 1593, 1594 (Fed. Cir. 1987).

between the claimed invention and the prior art. Thus, the Examiner has improperly arrived at the legal conclusion that the claimed invention is obvious based upon the combination of Maltz in view of Nozawa.

Notwithstanding the Examiner's failure to clearly designate the teachings in Maltz being relied upon in the statement of the rejection, the Examiner has failed to properly establishing the underlying facts regarding the scope and content of the prior art and the differences between the claimed invention and the prior art. For example, regarding the claimed "detecting a node in the cluster which requires re-configuration," the Examiner asserted "detecting scheduled collection/transmission of statistics" and cited paragraphs [0068]-[0069] and [0073] of Maltz for support. However, these cited passages are silent as to the claimed detection of a node which requires re-configuration. As already described by the Examiner, the teachings of Maltz describe collection of data, not detecting that a node requires re-configuration.

The Examiner further asserted the following on page 5 of the First Office Action regarding claims 6 and 12:

identifying a workload hosted by said node ([0068]) (generating statistical summaries based on collected traffic information and storing the statistic in repositories (i.e. database)) and retrieving a set of configuration parameters associated with said workload ([0070], [0076], [0033]) (retrieved the data stored in repositories as input).

Statistical summaries of collected traffic information are not comparable to the claimed "workload." Moreover, Maltz does not teaching "retrieving a set of configuration parameters associated with said workload." Instead, as described in paragraph [0033], Maltz teaches computing network element configurations based upon (i) inputs that represent the traffic

demand on the network, (ii) knowledge of network topology, and (iii) policy information.

Computing does not identically disclose retrieving.

The Examiner additionally asserted the following on page 5 of the First Office Action regarding claims 6 and 12:

producing a new generation of configuration parameters based upon said retrieved set using a computing process ([0033] and [0125]) (create configuration based on retrieved data stored in repositories using an algorithm)

The Examiner again mischaracterizes the teachings of Maltz. Moreover, the Examiner's analysis includes a logical inconsistency. As claimed, new configuration parameters are based upon a retrieved set of configuration parameters. However, Maltz does not teach producing a new generation of configuration parameters based upon the retrieved set of configuration parameters. Instead, Maltz teaches producing network element configurations based upon (i) inputs that represent the traffic demand on the network, (ii) knowledge of network topology, and (iii) policy information. The (i) inputs that represent the traffic demand on the network, (ii) knowledge of network topology, and (iii) policy information described by Maltz (i.e., the alleged retrieved set) would not be considered by one having ordinary skill in the art as "old" versions of "network element configurations." Thus, Maltz further fails to teach the limitations for which the Examiner is relying upon Maltz to teach.

Regarding the Examiner's obviousness analysis, the Examiner asserted the following in the paragraph spanning pages 5 and 6 of the First Office Action:

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Maltz and Nozawa because Nozawa's teaching of genetic computing process would enhance the configuration of Maltz's system by allowing genetic computing process to search for optimal configuration for the system.

1 The Examiner's analysis, however, ignores the teachings of Maltz. Specifically, the Examiner
2 has failed to establish that Maltz teaches saving old configurations, which can then be used to
3 create new configurations. Instead, Maltz teaches in paragraph [0033] that "the TMS Algorithm
4 200 outputs network element configurations to automatically direct data based on the traffic
5 demand." Thus, the algorithm employed by Maltz is based upon "traffic demand," which is
6 contemporaneous. On the contrary, a genetic computer process uses, in part, old information to
7 create the new generation. Maltz calculates the network element configurations based upon
8 contemporaneous information, yet the Examiner's analysis has failed to explain why one having
9 ordinary skill in the art would have been realistically impelled to modify Maltz so as to calculate
10 the network element configurations based upon old configurations. Instead, the Examiner's
11 analysis is conclusory without any factual basis.

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13 For above-described reasons, the Examiner has failed to establish that one having ordinary
14 skill in the art would have arrived at the claimed invention based upon the combination of Maltz and
15 Nozawa . Applicants, therefore, respectfully solicit withdrawal of imposed rejection of claims 6-17
16 under 35 U.S.C. § 103 for obviousness based upon Maltz in view of Nozawa.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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